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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/768,939 | 01/30/2004 | Thomas Robert Gold | 672P001 | 7176 |
| 42754 | 7590 | 06/02/2005 | EXAMINER | |
| NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581 | | | CHIU, RALEIGH W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3711 | |

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,939

Applicant(s)

GOLD, THOMAS ROBERT

Examiner

Raleigh Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/01/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the target side hand, in whole or in part, above the second hand (claim 31) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in the Constitution, the "patent clause" (Article I, section 8, clause 8) is limited to the promotion of advances in the "useful arts". Sports methods are not within the "useful arts" as that term is used in the U.S. Constitution. It has been recognized that "technological arts" is synonymous with the phrase "useful arts" as it appears in the Constitution. See *In re Waldbaum*, 173 USPQ 430. Holding a golf club or striking a golf ball is not technology and is unrelated to technology except insofar as the method requires the use of the products of technology. Rather than being within the

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technological or useful arts, the claimed method falls squarely within what can accurately be characterized as the recreational arts.

The discovery of a new movement of the human body using sports equipment whose purpose is to advance the recreational arts rather than the useful arts is not the kind of discovery or the type of function that the patent statutes were enacted to protect, e.g., see *Parker v. Flook*, 198 USPQ 193; *Diamond v. Diehr*, 209 USPQ 1.

Drawing an analogy to the "nutshell" holding in *Gottschalk v. Benson*, the granting of a patent to the method at issue here would effectively "pre-empt" specific human movement in an area where the public has heretofore enjoyed freedom of expression and movement in the pursuit of a widely popular recreational activity. See *Gottschalk v. Benson*, 175 USPQ 673.

Therefore, because a method of holding a golf club or striking a golf ball is not properly characterized as being within the useful of technological arts, and because Congress could not have intended to exceed the limited Constitutional grant of power to promote the useful arts when it enacted 35 USC 101, the claimed method is not eligible to receive a patent under the patent laws as they exist now.

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Furthermore, the recited steps do not fall within the classic definition of a process and, accordingly, is not a "process" within the meaning as used in 35 USC 101. The classic definition of a process is "an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing". See *Cochrane v. Deener*, 95 U.S. 780. Moreover, "transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines". See *Gottschalk v. Benson*, 175 USPQ 673.

In the instant case, the process claims do not include a particular machine and nothing is transformed or reduced to a different state or thing; all that is claimed is a process that is implemented by the movements of a human being without the aid of a machine. While the golf club and golf ball set forth in the claim are manipulated and moved in space, both elements remain precisely what they were before the process was performed. That is to say, they are implements used by an intervening human being and not machines used in or for carrying out the method. The result is that a human being moves, rather than transforms, subject matter from one point in space to another with the aid of implements. As a consequence, all that is left is a manipulation of subject matter, a procedure or a

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common dictionary-definition of a process, but not a process within the meaning of 35 USC 101.

Therefore, because the claimed method does not include a particular machine and because there is no transformation of subject matter so as to reduce it to a different state or thing, the claimed method is not properly characterized as a process within the meaning of the patent statutes and is thus ineligible to receive a patent.

Under recent Federal Circuit guidance in the context of computer-related inventions employing mathematical algorithms, the "useful, concrete and tangible result" test has emerged. See *In re Allapat*, 31 USPQ2d 1545; *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596; *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447.

While the instant case is non-machine implemented and does not relate to a mathematical algorithm, to the extent that the "useful, concrete and tangible result" test applies outside the context of computer algorithms, the claimed method of swinging a golf club is not sufficiently concrete because the claim requires such a degree of subjective human judgment that a reasonably consistent result cannot be predicted or assured.

Therefore, because the claimed method is merely limiting the natural motion of a person and does not serve to produce a

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result that can be fairly characterized as useful, tangible and concrete, it does not meet the modern test for patent-eligible subject matter and is therefore not eligible for patent protection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Because claims 1-34 are considered non-statutory, a person having ordinary skill in the art would not be able to perform the claimed invention as intended without undue experimentation.

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Claim Rejections - 35 USC §§ 102 and 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 2, 4 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,785,608 (Collins).

Regarding claims 1, 10 and 12, Figure 8 of Collins shows the club shaft 74 positioned in the armpit area of a player with the target side hand and other hand also gripping the shaft.

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Regarding claim 2, Figure 8 further shows the shaft exiting the palm between the thumb and forefinger of the target side hand.

Regarding claim 4, Figure 8 further shows the shaft exiting the palm between the thumb and forefinger of the other hand.

Regarding claim 7, Figure 8 shows the two hands to be overlapping.

Regarding claims 8 and 9, Figure 8 shows target arm 78 to be substantially extended and substantially parallel to the club shaft.

Regarding claim 11, the Collins club can inherently be used for chipping.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of U.S. Patent Application Publication Number 2004/0166956 (Shioda).

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a grip such that the club passes between the index finger and the ring finger of the target hand in view of Shioda who teaches that such a grip (Shioda, Figure 14) provides additional stability to a golfer during his swing.

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10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of U.S. Patent Number 5,913,738 (Carlucci).

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a fist of the other hand in view of Carlucci who teaches that such a grip prevents the player from "breaking" his wrists, thereby avoiding a problem contributing to inaccurate putts.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of U.S. Patent Number 5,616,089 (Miller) and applicant's admission of the prior art.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club by grasping the forearm of one hand with the target hand in view of Miller who shows that such a grip allows a player to use his non-dominant hand to stabilize the club. However, since applicant admits that a widely used variation of the putting grip is the "cross handed" grip (specification, page 4), it would have been obvious to one of ordinary skill in the art to provide a variant of the Miller stabilizing grip by reversing the position of the hands, thereby reducing the possibility of variation and error by allowing the target side hand to control the stroke.

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12. Claims 13, 14, 16, 19-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above.

Regarding claims 13, 14, 16 and 19-22, Collins describes Figure 8 at column 5, lines 34-50. Although Collins does not explicitly describe the shaft remaining in the armpit area during the putting stroke, it would have been obvious to one of ordinary skill in the art to do so for a consistent, continuous stroke.

Regarding claim 23, the Collins club can inherently be used for chipping.

Regarding claims 25, 27 and 28, a typical putting stroke is considered to meet the recited movements.

Regarding claims 26 and 29, as many putting strokes and techniques translate well to other short-game strokes such as chipping, it would have been obvious to one of ordinary skill in the art to extend the Collins teaching to chipping strokes as well; the chipping stroke is considered to meet the recited shoulder movements.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of Shioda as applied above.

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Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a grip such that the club passes between the index finger and the ring finger of the target hand in view of Shioda who teaches that such a grip (Shioda, Figure 14) provides additional stability to a golfer during his swing.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of Carlucci as applied above.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club with a fist of the other hand in view of Carlucci who teaches that such a grip prevents the player from "breaking" his wrists, thereby avoiding a problem contributing to inaccurate putts.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied above in view of Miller and applicant's admission of the prior art as applied above.

Alternatively, it would have been obvious to one of ordinary skill in the art to hold the Collins club by grasping the forearm of one hand with the target hand in view of Miller who shows that such a grip allows a player to use his non-dominant hand to stabilize the club. However, since applicant admits that a widely used variation of the putting grip is the

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"cross handed" grip (specification, page 4), it would have been obvious to one of ordinary skill in the art to provide a variant of the Miller stabilizing grip by reversing the position of the hands, thereby reducing the possibility of variation and error by allowing the target side hand to control the stroke.

16. Claims 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication Number 2004/0166956 (Shioda).

Regarding claim 30, Figures 14-23 show the recited grips by the target side hand and the other hand.

Regarding claim 31, Figures 15-16 show the target side hand partially above the other hand.

Regarding claim 32, Figures 20-21 show the target side hand below the other hand.

Regarding claim 33, Figures 6-12 appear to show a putter.

17. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shioda as applied above.

As Shioda discloses his grip does not create additional tension in the golfer's arm, thereby preventing extraneous motion, one of ordinary skill would realize that such a benefit would apply to all golf strokes, including chipping.

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Conclusion

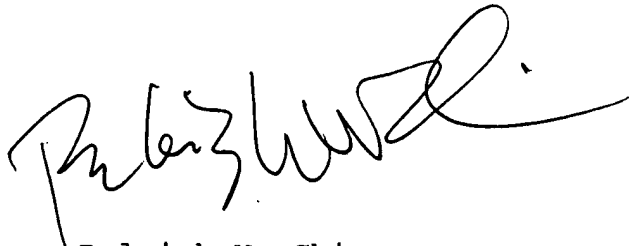
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (571) 272-4415.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
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RWC:dei:feif
26 May 2005